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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,038	04/06/2006	John Fred Eaddy III	PR60507USW	5949
23347 7590 11/27/2007 GLAXOSMITHKLINE CORPORATE INTELLECTUAL PROPERTY, MAI B475 FIVE MOORE DR., PO BOX 13398 RESEARCH TRIANGLE PARK, NC 27709-3398			EXAMINER NAGUBANDI, LALITHA	
			ART UNIT 1621	PAPER NUMBER
			NOTIFICATION DATE 11/27/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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JULIE.D.MCFALLS@GSK.COM

<b>Office Action Summary</b>	Application No. 10/575,038	Applicant(s) EADDY ET AL.	
	Examiner Lalitha Nagubandi	Art Unit 1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 14 is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9, 10, 12 and 32-35 is/are rejected.
- 7) ☒ Claim(s) 8 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/6/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

***Detailed Office Action***

***Status of Claims***

Claims 1- 12, 14 and 32-35 are pending. Claims 1- 12, 14 and 32-35 are considered for examination in this office action.

***Election/Restriction***

Applicants' election with traverse of Group I (claims 1-12,14 and 32-35), and further elect compound 35 as described in example 22 of the specification as the species, in the reply to our earlier office action dated August 16<sup>th</sup> 2007 is acknowledged.

***Response to Argument***

Applicants' election was made with traverse of Group I and applicant argues that the methods of treatment claims of Group III and the process claims of Group II are linked by dependency to the compound claims of Group I.

Since the instant application required a restriction between product and process as indicated in the earlier office action dated July 12<sup>th</sup> 2007 the election requirement was considered proper and the lack of unity between the groups is maintained.

However, the examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise

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require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b).

Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Hence the restriction requirement dated May 10<sup>th</sup> 2007 is made **FINAL**.

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***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

***Allowable Subject Matter***

The elected species was found allowable. The search was extended further to claims 1-3 to the extent that reads on the elected species. Claim 1-3 are found allowable when R<sup>1</sup> is - PO<sub>3</sub>H<sub>2</sub> as embodied in the claims. Further, the search was extended to the genus which reads on claims 1- 12 and 14 and found allowable.

The following is a statement of reason for the indication of allowable subject matter:

Claims 1-5 and 14 are allowable as directed to compound of formula (I) as embodied in the instant claims and render unobvious to one skilled in the art as the closest prior art of record does not teach or suggest the instant products.

Claims 8 and 11 are objected to being dependent on rejected claims, would be allowable if rewritten in independent form.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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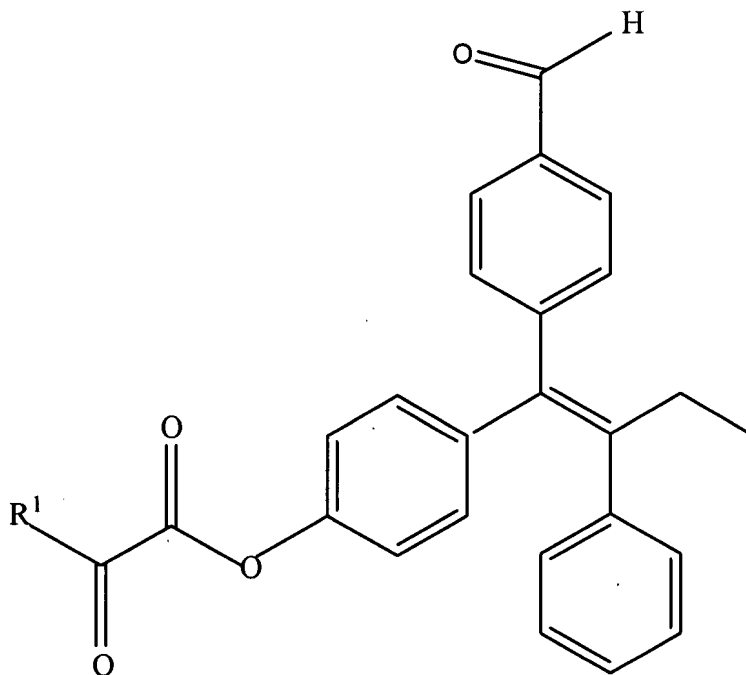
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

**Claim 12** is indefinite because a named compound is unclear, see lines 7-8.

**Claim 32** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

In claim 32 the formula IV is confusing. When  $R^1$  is  $-C(O)\text{-alkyl}$  ... as embodied in the claim the formula IV is interpreted as follows:



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Formula IV as interpreted when  $R^1$  = alkyl, aryl, heteroaryl..... as embodied in claim 32.

It is unclear whether this compound is the intended invention. Appropriate correction to formula IV should be made.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6,7,9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Weatherman et al ( Chemistry and Biology 8 (2001) 427 –436).

Claim 6, the phrase ‘ R\* is any prodrug moiety’ reads on the compounds disclosed by Weatherman et al thus anticipating the instant claims. ( please see page 429, Scheme 1, compounds 13 and 16, more specifically compound 16 where R = tBu. Chemistry and Biology 8 (2001) 427 –436).

### ***Conclusion***

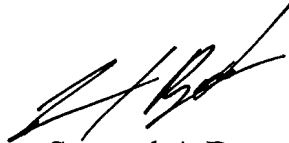
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalitha Nagubandi whose telephone number is 571 272 7996.

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The examiner can normally be reached on 6.30am to 3.30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eyler, Yvonne can be reached on 571 272 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lalitha Nagubandi  
Patent Examiner  
Technology Center 1600  
November 15<sup>th</sup>, 2007.



Samuel A Barts

Primary Patent Examiner  
Technology Center 1600